

This Opinion is Not a  
Precedent of the TTAB

Mailed: May 9, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Pleiades Publishing, Inc.*  
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Serial No. 88767882  
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Thomas E. Watson of Amin Turocy & Watson LLP,  
for Pleiades Publishing, Inc.

Alison Keeley, Trademark Examining Attorney, Law Office 113,  
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Before Kuhlke, Goodman and Lebow,  
Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

On January 21, 2020, Pleiades Publishing, Inc. (Applicant) filed an application under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051, based on an allegation of first use and first use in commerce on December 31, 2005, to register MICROBIOLOGY in standard characters for goods identified as “Downloadable electronic publications, namely, a series of journals published periodically on subjects related to fundamental and applied microbiology,” in International Class 9.

Registration was originally refused under Sections 1, 2, and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052, 1127, on the ground that MICROBIOLOGY is generic for Applicant's goods or, in the alternative, merely descriptive and the evidence of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f), is insufficient. Applicant subsequently filed an amendment to seek registration on the Supplemental Register. In response, the Examining Attorney refused registration on the Supplemental Register under Sections 23(c) and 45 of the Trademark Act, 15 U.S.C. §§ 1091(c) and 1127, on the ground that MICROBIOLOGY is incapable of identifying Applicant's goods.<sup>1</sup>

In view of Applicant's amendment, the sole issue in the appeal is whether MICROBIOLOGY is generic for Applicant's goods, and thus, unregistrable on the Supplemental Register.<sup>2</sup>

"A generic name--the name of a class of products or services--is ineligible for federal trademark registration." *U.S. Patent & Trademark Office v. Booking.com B.V.*, 140 S. Ct. 2298, 2020 USPQ2d 10729, \*2. Generic terms are "by definition incapable of indicating source, are the antithesis of trademarks, and can never attain trademark status." *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987) quoted in *In re Cordua Rests., Inc.*, 823 F.3d

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<sup>1</sup> Applicant amended to the Supplemental Register on March 2, 2021.

<sup>2</sup> Citations to TTABVUE throughout the decision are to the Board's public online database that contains the appeal file, available on the USPTO website, [www.USPTO.gov](http://www.USPTO.gov). The first number represents the docket number in the TTABVUE electronic case file and the second represents the page number(s).

Citations to the examination record refer to the USPTO's online Trademark Status and Document Retrieval system (TSDR).

594, 118 USPQ2d 1632, 1634 (Fed. Cir. 2016). “Generic terms are common names that the relevant purchasing public understands primarily as describing the genus of goods or services being sold. They are by definition incapable of indicating a particular source of the goods or services.” *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1810 (Fed. Cir. 2011) (citations omitted). *See also Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1045-46 (Fed. Cir. 2018).

Whether a proposed mark is generic rests on its primary significance to the relevant public. *In re Am. Fertility Soc’y*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); *see also USPTO v. Booking.com B.V.*, 2020 USPQ2d 10729, at \*5. Making this determination “involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?” *H. Marvin Ginn Corp. v. Int’l Ass’n. of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986); *see also Royal Crown*, 127 USPQ2d at 1046. “[A] term can be generic for a genus of goods or services if the relevant public . . . understands the term to refer to a key aspect of that genus.” *Cordua Rests.*, 118 USPQ2d at 1637.

#### A. Genus of Goods

Because the identification of goods or services in an application defines the scope of rights that will be accorded the owner of any resulting registration under Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b), generally “a proper genericness

inquiry focuses on the description of [goods and/or] services set forth in the [application or] certificate of registration.” *Cordua Rests.*, 118 USPQ2d at 1636 (quoting *Magic Wand*, 19 USPQ2d at 1552). In this case, we find that the identification appropriately expresses the genus of goods at issue.

Thus, the ultimate inquiry is whether the relevant public understands MICROBIOLOGY to refer to downloadable electronic publications, namely, a series of journals published periodically on subjects related to fundamental and applied microbiology. Applicant argues that the relevant consumers are:

... a specialized group of scientific researchers, authors, students, and library consortiums that use and purchase the goods. Applicant’s goods run through the channel of scholarly publications and encounter authors looking to publish their works, researchers looking for new information and students studying scientific topics. The downloadable publications are bought by large library consortia under expensive subscriptions to the academic journals. Here, Applicant provides scientific journals for a sophisticated market of researchers, students, and research libraries. The journals are also marketed to scientific research authors looking to publish their works in prominent publications. Researchers and students are selective about citing sources from publications and take great care in the utilization of published works featured in Applicant’s journals. Authors are just as selective when deciding where their research should be published. Thus, the purchasing or consuming public for Applicant’s identified goods is a specialized group who would not consider the MICROBIOLOGY mark primarily as a reference to “downloadable electronic publications, namely, a series of journals published periodically on subjects related to fundamental and applied microbiology.”

Applicant’s Brief, 6 TTABVue 10.

We base our analysis on the goods as identified and, here, there is no specific limitation as to the type of consumer. However, based on the identification itself, the

subject matter of Applicant's goods would be most relevant to consumers interested in the field of microbiology which would include researchers, students and research libraries. While we find that based on the inherent nature of the goods the relevant consumer would at least have an interest in microbiology, that could include consumers with less knowledge or experience in the field than Applicant portrays. *Cf. Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1163 (Fed. Cir. 2014) (Board makes determination based on the least sophisticated consumer). Thus, as identified, the relevant public comprises consumers who purchase electronic journals on microbiology. *The Loglan Inst. Inc. v. The Logical Language Grp.*, 962 F.2d 1038, 1041, 22 USPQ2d 1531, 1533 (Fed. Cir. 1992) (quoting *Magic Wand*, 19 USPQ2d at 1553).

B. Does the Relevant Public Understand MICROBIOLOGY Primarily Refers to the Genus?

"Evidence of the public's understanding of the term may be obtained from any competent source, such as purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers and other publications." *Merrill Lynch*, 4 USPQ2d at 1143; *see also Cordua Rests.*, 118 USPQ2d at 1634. In some cases, dictionary definitions and an applicant's own recitation of goods or services may suffice to show genericness. *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1112 (Fed. Cir. 1987); *see also Am. Fertility Soc'y*, 51 USPQ2d at 1836.

The Examining Attorney first points to the definition of the word MICROBIOLOGY as “The branch of science that deals with microorganisms.”<sup>3</sup> The Examining Attorney further supports the refusal with the evidence summarized below.

#### Titles of Third-Party Publications

- Listing of science journals from scimagojr.com, microbiologyinfo.com, guides.lib.umich.edu, microbiologysociety.org, microbenotes.com, including Nature Reviews Microbiology, Nature Microbiology, Microbiology and Molecular Biology Reviews, Annual Review of Microbiology, FEMS Microbiology Reviews, Trends in Microbiology, Current Opinion in Microbiology, Current Topics in Microbiology and Immunology, Environmental Microbiology, Molecular Microbiology, Cellular Microbiology, Clinical Microbiology Reviews, Journal of Medical Microbiology<sup>4</sup>
- Excerpt from wmicsonline.org providing a list of “Microbiology Journals,” the titles of which also point to various sub-disciplines, including Journal of Infectious Diseases & Therapy, Virology & Antiviral Research, Journal of Immunological Techniques & Infectious Diseases, Archives of Clinical Microbiology, Journal of Pharmaceutical Microbiology<sup>5</sup>
- Listing of microbiology journals from imedpub.com, think.taylorandfrancis.com, researchgate.com, alliedacademies.org, caister.com, including Microbiology & Immunology, Journals of Microbiology & Immunology Research, Journal of Clinical Microbiology, International Journal of Microbiology, Journal of Current Microbiology, International Journal of Current Microbiology and Applied Sciences, Journal of Oral Microbiology, Current Opinion in Microbiology, Clinical Microbiology and Infection, International Journal of Food Microbiology, Environmental Microbiology Reports, Annals of Clinical Microbiology and Antimicrobials, Journal of Plant Biotechnology and Microbiology, Diagnostic Microbiology and Infectious Disease<sup>6</sup>

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<sup>3</sup> March 25, 2020 Office Action, TSDR at 2 (Lexico, <https://www.lexico.com>); *see also Id.* at 3-21 (ENCYCLOPAEDIA BRITANNICA, <https://www.britannica.com>).

<sup>4</sup> *Id.* at 22-53.

<sup>5</sup> October 13, 2020, TSDR at 2-5.

<sup>6</sup> *Id.* at 9-39.

### Third-Party Use of Microbiology to Refer to a Category of Publications

- Listing of “Microbiology Books” from microbiologyinfo.com, wiki.ezvid.com, including Diagnostic Microbiology, Foundations in Microbiology, Microbiology, Microbiology & Immunology, Medical Microbiology<sup>7</sup>
- Excerpt from quora.com forum post with users discussing “What are the best microbiology journals”<sup>8</sup>
- Excerpt from Wikipedia.org listing a category of “Microbiology journals”<sup>9</sup>
- Excerpt from Frontiersin.org touting their own journal as “among the world’s top microbiology journals”<sup>10</sup>

### Applicant’s Website Referring to Key Aspect of the Goods

- Excerpt from Pleiades.online describing “an international peer reviewed journal that covers a wide range of problems in the areas of fundamental and applied microbiology”<sup>11</sup>

The Examining Attorney concludes from this evidence that:

MICROBIOLOGY identifies a key aspect and component of applicant’s goods, the general field or focus of the goods. This is a common category of publication and is very commonly used to indicate that publications are in this field of study.

Ex. Att. Brief, 8 TTABVUE 9.

Applicant argues the Examining Attorney’s evidence:

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<sup>7</sup> March 25, 2020 Office Action, TSDR at. 54-76.

<sup>8</sup> October 13, 2020 Office Action, TSDR at 40-44.

<sup>9</sup> *Id.* at 6-8.

<sup>10</sup> *Id.* at 45-50.

<sup>11</sup> October 13, 2020 Office Action, TSDR at 51. *See In re Reed Elsevier Props.*, 482 F.3d 1376, 82 USPQ2d 1378, 1380 (Fed. Cir. 2007) (appropriate to consider the applicant’s website to provide context for and inform the understanding of the identification); *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420 (Fed. Cir. 2005) (examining the subject website in order to understand the meaning of terms).

... underscores that consumers in the marketplace are accustomed to journal titles utilizing common scientific terms but understand that the journal titles carry brand recognition. ... Overall, the evidence indicates that consumers are routinely exposed to trademark uses of Applicant's mark in numerous forms and through various media. ... [and] indicates that consumers can reasonably recognize MICROBIOLOGY as an indicator of source rather than as a generic term because of numerous other instances in which consumers encounter journal titles acting as brand identifiers. At most Applicant's mark is descriptive of the goods. As the Examiner notes, microbiology is a major field of scientific study with numerous academic journals and publications in the field. The subject matter merely describes a characteristic of Applicant's goods indicating the mark should be deemed as descriptive. ... The MICROBIOLOGY mark is not used generically to refer to all electronic series of journals. Nor is the mark used generically to refer to journals focused on the study of the scientific field of microbiology.

App. Brief, 6 TTABVue 6, 8.

While the various journal titles use the word MICROBIOLOGY, they include other wording that creates combinations that may be capable of indicating source, whereas Applicant seeks to register the word MICROBIOLOGY by itself. The record shows that on its own, the word "microbiology" is used to refer to a category of publications ("Microbiology Books" "Microbiology Journals").

In support of its position that MICROBIOLOGY is capable of source-identifying significance, Applicant submitted the letter of Professor Alexander V. Kabanov, who



has “submitted numerous research articles to the journals owned by [Applicant].”<sup>12</sup>

Dr. Kabanov writes that:<sup>13</sup>

As the author of many research articles I can attest to the fact that the numerous journals titles are treated as brands within the industry. The titles of the journals themselves act as the identifying source of the publications. It is widely understood that the titles of [Applicant’s] journals indicate the source of the electronic publications that are available for down load at Springer Link. ... I am very intentional about where I choose to publish my work and I look to be published in certain journals for their brand recognition. Many brands of journals in the scientific field use similar names but it is common practice for authors and readers alike to differentiate between the different sources that are available. Each of the journals that are published by [Applicant] are individually known as the source of thoroughly researched articles and it is widely understood in the scholarly community that titles of the journals act as brand identifiers.

In addition, Applicant submitted its own and third-party registrations for a series of downloadable or non-downloadable electronic or printed publications for the following marks that contain the word “MICROBIOLOGY” or other science-related words:<sup>14</sup>

- APPLIED BIOCHEMISTRY AND MICROBIOLOGY (Supplemental Register - Applicant)
- MOLECULAR GENETICS, MICROBIOLOGY AND VIROLOGY (Supplemental Register - Applicant)
- MICROBIOLOGY RESOURCE ANNOUNCEMENTS and design (MICROBIOLOGY RESOURCE ANNOUNCEMENTS disclaimed)

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<sup>12</sup> September 24, 2020 Response, TSDR at 6.

<sup>13</sup> *Id.* Applicant and Dr. Kabanov refer to him attesting to this information; however, this letter was not submitted under oath or a declaration pursuant to Trademark Rule § 2.20, 37 C.F.R. § 2.20.

<sup>14</sup> September 16, 2021 Response, TSDR 6-19.

- MICROBIOLOGY SPECTRUM and design (MICROBIOLOGY SPECTRUM disclaimed)
- MEDICINE (Section 2(f) acquired distinctiveness)
- NATURE (Section 2(f) acquired distinctiveness)

Applicant's argument that these prior registrations support registration of MICROBIOLOGY is not persuasive. Two involve different words and are more general terms than the specific field of microbiology. As to the remaining examples, they are word combinations, not the specific term "microbiology" by itself. In any event, we are not bound by the decisions of examining attorneys on other records. *See In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001) (holding ULTIMATE BIKE RACK merely descriptive of "bicycle racks" despite the presence of "ultimate" without a disclaimer in other marks on the Principal Register); *In re Scholastic Testing Serv., Inc.*, 196 USPQ 517, 519 (TTAB 1977) (holding SCHOLASTIC merely descriptive of devising, scoring, and validating tests for others despite the presence of other marks on the Register using the word "Scholastic").

Overall, the evidence shows MICROBIOLOGY used to refer to a key aspect or a category of publications. *See Cordua Rests.*, 118 USPQ2d at 1637 (CHURRASCOS a type of grilled meat generic for restaurant services); *In re Am. Inst. of Certified Pub. Accountants*, 65 USPQ2d 1972 (TTAB 2003) (finding CPA EXAMINATION generic for "printed matter, namely, practice accounting examinations; accounting exams; accounting exam information booklets; and prior accounting examination questions and answers"). Thus, Applicant's proposed mark is generic for the identified goods.

*Royal Crown*, 127 USPQ2d at 1045; *Cordua Rests.*, 118 USPQ2d at 1637.

Notwithstanding the single letter from one of Applicant's published authors, we find the relevant consuming public would understand MICROBIOLOGY to refer to a key aspect or category of publications and is therefore incapable of indicating source.

**Decision:** The refusal to register MICROBIOLOGY on the Supplemental Register on the ground that it is a generic designation under Section 23 is affirmed.